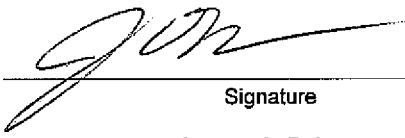


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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
		00-007	
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on <u>05/30/08</u>		09/609253	06/30/00
Signature _____		First Named Inventor	
Typed or printed name <u>Leann Baker</u>		Jay Walker	
		Art Unit	Examiner
		3687	Frenel, Vanel
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the			
<input type="checkbox"/> applicant/inventor.		Signature	
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)		Jerome A. DeLuca	
<input checked="" type="checkbox"/> attorney or agent of record.		Typed or printed name	
Registration number <u>55106</u>		203-461-7319	
		Telephone number	
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34.		05/30/08	
Registration number if acting under 37 CFR 1.34 _____		Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			

<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.
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This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**CUSTOMER NO. 22927**

Application No.: 09/609,253Appellants: Walker et al.Filed: June 30, 2000

**Title:** METHODS AND APPARATUS FOR INCREASING AND/OR FOR MONITORING A  
PARTY'S COMPLIANCE WITH A SCHEDULE FOR TAKING MEDICINES

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Appellants respectfully request a Pre-Appeal Brief Conference to review the rejections set forth in the Office Action mailed January 30, 2008 (hereinafter, the "Present Office Action"). Appellants below demonstrate that after seven Office Actions and two previous successful Appeals, those references identified by the Office as most relevant still do not teach or suggest any of the pending claims.

Appellants accordingly request that the Conference allow all of the pending claims. Appellants also outline some clear errors in examination that must be corrected prior to any appeal of the present rejections. No amendments are being filed with this Request, and this Request is being filed concurrently with a Notice of Appeal.

Claims **2, 3, 5-47, 49, 50 and 116-125** are pending, and claims **2, 49 and 116** are the only independent claims.

Claims **49, 50 and 116-125** stand rejected under 35 U.S.C. §102(a) as being anticipated by U.S. Patent No. 5,950,632 to Reber et al. (hereinafter "Reber").

Claims **2, 3 and 5-47** stand rejected under 35 U.S.C. §103(a) as being unpatentable over Reber in view of U.S. Patent No. 6,529,446 to de la Huerga et al. (hereinafter "de la Huerga") and further in view of U.S. Patent No. 6,294,999 to Yarin et al. (hereinafter "Yarin").

**I. The Examiner Makes Contradictory Statements Concerning the Teachings of the References and Has Ignored the Findings of the Appellants' Two Prior Appeals.**

The Present Office Action states at page 2 that Reber discloses "a communication device adapted to wirelessly communicate at least one signal between the medicine container and at least one other medicine container." However, the same Office Action admits at page 6 that "[a]s best understood, the combination of Reber and de la Huerga do not explicitly disclose

wirelessly communicating a signal between the first container and the second container the second container adapted to store a second medicine,” and relies on Yarin for this limitation. In fact, none of the cited references, disclose, teach or suggest this feature.

The source of this discrepancy appears to be the fact that the Examiner has copied a previously abandoned rejection from a prior Office Action in lieu of performing actual analysis. The Office Action, mailed January 17, 2007 (hereinafter the “1/07 Office Action”), contained two grounds of rejection: claims 49, 50 and 116-125 rejected under §102(a) in view of Reber (copied verbatim into the Present Office Action); and claims 2, 3 and 5-47 rejected under §103(a) in view of Reber and de la Huerga (combined with Yarin in the Present Office Action).

The following Final Office Action, mailed on July 26, 2007 (hereinafter the “7/07 Office Action”), withdrew the §102 rejection and instead rejected all pending claims under §103 as being unpatentable over Reber in view of de la Huerga. In response, Appellants filed an appeal and accompanying pre-appeal request for review on December 21, 2007 (hereinafter the “12/07 Appeal”). The 12/07 Appeal successfully argued, *inter alia*, that neither Reber nor de la Huerga teaches or suggests all the limitations of the claims. Prosecution was reopened on this basis and the Present Office Action, mailed on January 30, 2008, explicitly states at page 2 that “Applicant’s arguments filed on 12/12/07 [sic] have been persuasive, therefore the prior Office Action has been withdrawn and a new Office Action is hereby presented.”

Despite the clear admission by the Office that not even the combination of Reber and de la Huerga shows these limitations, the present Office Action has copied its abandoned and discredited §102 rejection of 49, 50 and 116-125 from the 01/07 Office Action. The present § 102 rejections suffer from clear error(s) if they were included by mistake, and must be withdrawn. If they were an intentional reassertion, they are also in clear error, as the present Office Action is internally inconsistent in its findings with respect to Reber and de la Huerga, and the record already included (1) acknowledgment in the Present Office Action that the rejection is improper and (2) successful arguments by Appellants that have not been rebutted in the present Office Action.

The Present Office Action’s “new” §103 rejection of claims 2, 3 and 5-47 at least acknowledges that Reber and de la Huerga fail to disclose all the limitations of the claims, but the newly cited Yarin reference discloses nothing new. As Appellants demonstrate below, Yarin

discloses features similar to Reber, that operate the same way as Reber, and which fail to meet the limitations of the claims for the same reasons as Reber. The medicine containers of Yarin cannot communicate with each other any more than the containers of Reber.

In the hopes of advancing prosecution by addressing the obvious examination errors, Appellants scheduled a telephonic interview with Examiner Frenel for April 30, 2008. Appellants specifically asked in advance that the Examiner be prepared to clarify the contradictory statements regarding the teachings of Reber (or lack thereof) at pages 2 and 6 of the Present Office Action. Despite this advance request, the Examiner during the interview was unwilling or unable to reconcile these statements, and instead suggested that Appellants' "address it in your response." The Examiner also could not identify any feature in Reber, de la Huerga or Yarin that disclosed wireless communication between two medicine containers, and was unable to articulate any differences between the Reber and Yarin references, or why Yarin succeeds in meeting the limitations where Reber fails.

## **II. None of Reber, de la Huerga or Yarin Teaches or Suggests Communications Between Two Medicine Containers**

Appellants respectfully submit that even after seven Office Actions that rely on combinations of these same two references, the Examiner continues to misinterpret Reber and de la Huerga. Appellants also respectfully submit that the Examiner misinterprets the newly cited reference Yarin. The present rejections relying upon these misinterpretations are in error. Provided immediately below are brief summaries of these references.

Reber and Yarin both disclose a medical communication apparatus (See Reber, Fig. 1:20; Yarin Fig. 3:12) to assist end users in complying with prescriptions for taking medicine. In a described embodiment of Reber, a communication apparatus 50 (Fig. 2) acts as a base station to communicate wirelessly with one or more medicine containers 52 (col. 4, lines 27-40). In another implementation of Reber, a communication apparatus 100 (Fig. 3) communicates with each of three medicine containers (102, 104, 106) by reading machine-readable data (112, 120, 126) from a label (110, 116, 124) attached to each medicine container (col. 7, line 55 to col. 8, line 5). Similarly, an embodiment of Yarin teaches a base station 12 that may identify medicine containers 34 via an RF electromagnetic tag reader 41. Thus, Reber and Yarin both teach to use

a single, central communication apparatus or base station for communicating with one or more medicine containers.

de la Huerga discloses an interactive medicine container or console that holds or organizes one or more medication containers or vials. Each vial has a memory strip containing medication and prescription information, and the console reads this information and interacts with a patient to remind them to take the medication (see de la Huerga, col. 3, line 62 to col. 4, line 3). In an illustrative embodiment, a medical organizing system 1300 (Fig. 42) has medicine containers that are removably secured to a dispenser 1310 (col. 47, lines 15-18). The dispenser 1310 comprises a housing having slots 1319 that are configured to mate with a plate 1104 of each medicine container (col. 47, lines 35-38). Each medicine container has an interactive label 1106 (see Figs. 35 and 37) that includes a memory strip 60 including contacts 62. When a medicine container is fully engaged in the slot 1319, the contacts 62 physically and electrically connect to contacts 1150 of dispenser 1310 so that a processor 1378 can then read the memory strip 60. Another embodiment includes a container having contacts 62 that are arranged as a series of stripes, and this container fits into a round hole of the dispenser, wherein the round hole is sized such that contacts 1150 of the dispenser are in electrical contact with the contacts 62 of a vial (col. 48, lines 10-26). Each of de la Huerga's example systems requires a medicine container to be in electrical contact with contacts 62 of a dispenser to communicate information between the dispenser and the medicine container.

1. **Independent Claim 2 is Patentably Distinct From the Cited References**

Independent claim 2 is directed to a method that includes:

*wirelessly communicating a signal between a first container adapted to store the first medicine and a second container, the second container adapted to store a second medicine.*

There is no disclosure, teaching or suggestion in Reber, de la Huerga or Yarin, alone or in combination, of these features. The Examiner admits that Reber and de la Huerga fail to teach such a feature (Present Office Action, page 6), and Appellant's 12/07 Appeal successfully established that Reber and de la Huerga do not meet these limitations. The Present Office Action relies on Fig. 3 and Col. 9:21-41 of Yarin as "suggest[ing] that the method having wirelessly communicating a signal between the first container and the second container adapted to store a second medicine [sic]." But this cited portion of Yarin discloses that the medicine containers are

capable of communicating only with the smart tray 12 and *not* with each other. As with Reber, Yarin does *not* teach or suggest “wirelessly communicating a signal between a first container and a second container.” Thus, the Examiner has misinterpreted the teaching of the cited references.

In view of the above remarks, Appellants respectfully submit that the cited art does *not* teach or suggest the features recited by claim 2. Accordingly, the rejection of claim 2 under Section 103(a) cannot stand. In addition, dependent claims 3 and 5-47 should be allowable for at least the same reasons as claim 2.

2. **Independent Claims 49 and 116 Are Not Anticipated by Reber and is Patentably Distinct From the Cited References**

Independent claim 49 is directed to a medicine container that includes:

*a communication device adapted to wirelessly communicate at least one signal between the medicine container and at least one other medicine container.*

Independent claim 116 is directed to a method that includes:

*obtaining a first container for storing a first medicine, the first container being capable of wirelessly communicating with a second container for storing a second medicine; and*

*storing a first medicine in the first container.*

For the sake of brevity, Appellants incorporate by reference herein the arguments presented above concerning claim 2. In particular, the Present Office Action admits at page 6 that “[a]s best understood, the combination of Reber and de la Huerga do not explicitly disclose wirelessly communicating a signal between the first container and the second container the second container adapted to store a second medicine.” In fact, none of Reber, de la Huerga or Yarin teaches or suggests a first medicine container configured to wirelessly communicate with a second medicine container. Accordingly, independent claims 49 and 116, and dependent claims 50 and 117-125 should be allowable over the cited references for at least the same reasons as claim 2.

**III. Conclusion**

Appellants respectfully request review and reversal of all of the pending rejections.

Respectfully submitted,

May 30, 2008  
Date

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